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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,173	03/09/2001	Chong Seng Cheng	1601457-0004	9334

7590 11/19/2003

White & Case LLP  
Attn: Patent Department  
1155 Avenue of the Americas  
New York, NY 10036

EXAMINER

CHOI, WOO H

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 11/19/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/803,173	CHENG, CHONG SENG	
	<b>Examiner</b>	<b>Art Unit</b>	
	Woo H. Choi	2186	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-21 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☒ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on a PCT application PCT/SG00/00029 filed in Singapore on February 21, 2000. It is noted, however, that while applicant has filed a certificate, the annexed document or the actual copy of the PCT application PCT/SG00/0029 has not been filed as required by 35 U.S.C. 119(b).

### ***Claim Objections***

2. Claims 9 and 10 are objected to because of the following informalities:

Claim 9 includes an acronym USB. An acronym should be spelled out before its first appearance in a claim.

Claim 10 ends with a semicolon. All claims should terminate with a period.

Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9, 13, 17 – 18, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. With respect to claims 9 and 18, the claims recite the limitation “without cable interconnection.” This limitation is not supported by the original specification. The specification does not discuss either the presence or absence of cable connection. The Examiner asks Applicant to specifically point out where in the specification the above limitation is supported.

6. With respect to claim 13, neither FRAM nor MRAM is disclosed anywhere in the specification.

7. With respect to claims 17 and 21, the degree of compactness claimed is not supported by the specification. Description of a device that is “sufficiently compact to be held within a human hand for maximal portability” is not found in the specification.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 9 – 12, 14 – 15, 17 – 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Yao (Us Patent No. 6,385,677).

10. With respect to claims 9, 10, 12, 14, and 18, Yao discloses a portable data storage device (Figure 2) comprising:

a USB plug adapted to the device to facilitate direct coupling of the device via the USB plug to a USB socket on a computer without cable interconnection (Figure 6, 40);

a USB driver coupled to the USB plug (Figure 2, 13) ;

flash memory (Figure 2, 20, col. 2, lines 54 – 57); and

a micro-controller coupled to the flash memory (Figure 2, 11), the micro-controlled being coupled between the USB driver and the flash memory to control the flow of data.

11. With respect to claim 11, the memory device comprises a read/write memory (Flash memory device is a read/write device. See also col. 2, lines 4 – 6).

12. With respect to claims 15 and 19, the micro-controller includes a read only memory which stores a program to control the operation of the micro-controller (Claim 2, micro-controller has an associated firmware).

13. With respect to claims 17 and 21, the portable data storage device is sufficiently compact to be held within a human hand for maximal portability (See figure 5, for relative size of the device).

14. Claims 16 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller (US Patent No. 6,038,320).

Miller discloses a portable data storage device (Figure 3) comprising:

a USB plug adapted to the device to facilitate direct coupling of the device via the USB plug to a USB socket on a computer without cable interconnection (Figure 3, 48, see also col. 59 – 61);

a USB driver coupled to the USB plug (Not explicitly shown as a separate element in the figure but it is a required element for any device that interfaces with USB. Seems to be an integral part of the controller 42 in figure 3. See also col. 2, lines 63 – 67);

flash memory (Figure 3, 46); and

a micro-controller coupled to the flash memory, the micro-controlled being coupled between the USB driver and the flash memory to control the flow of data (Figure 3, 42, seems to include a USB driver, see col. 2, lines 63 – 67),

wherein the micro-controller facilitates user authentication to restrict unauthorized users for obtaining access to at least a portion of information stored in the memory device (Figure 4A).

15. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (US Patent No. 6,457,099).

A portable data storage device (Figures 1 and 2, 100, PDAC) comprising:

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a USB plug adapted to the device to facilitate direct coupling of the device via the USB plug to a USB socket on a computer without cable interconnection (col. 7, lines 12 – 16 and, 22 – 26);

a memory device including non-volatile solid-state memory (Figure 1, 106 EPROM, 108 EEPROM) wherein the memory comprises a ferroelectric random access memory (FRAM) (col. 3, line 37 – 45) or a magnetic random access memory (MRAM); and

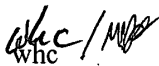
a memory control device coupled to the memory device for controlling data flow between the memory device and the USB plug (Figure 1, 102 Processor, 104 DMA controller).

### *Conclusion*

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Woo H. Choi whose telephone number is (703) 305-3845. The examiner can normally be reached on M-F, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (703) 305-3821. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
whc

November 12, 2003

  
MATTHEW KIM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100